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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/081,872	05/20/1998	JOHN H. MESSING		2041

7590
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02/27/2004

EXAMINER

MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/081,872

Applicant(s)

MESSING, JOHN H.

Examiner

Douglas J. Meislahn

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003 and 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 99-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 99-126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to declaration filed 19 December 2003 and the amendment filed 01 December 2003 that amended the specification, cancelled claims 79-98, and added claims 99-126. Applicant reinstates claims 76-78. These claims were cancelled by the amendment filed 10 June 2003. Once cancelled, claims cannot be reinstated. If applicant wishes the subject matter of these claims to be considered, refile them as added claims.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive. The declaration fails to provide a distinction between the application's claims and the cited prior art. Thus, the declaration is unpersuasive.

The examiner disagrees with applicant's assessment of Kocher. Applicant opines that Kocher, while meeting a need for timestamping, does not affix a signature on behalf of another. Since the timestamping entity is invoked at the request of a document's originator, Kocher teaches timestamping on behalf of another. Furthermore, in lines 38-45 of column 10, Kocher specifically describes timestamping with an RSA signature. This meets the limitations of applicant's new claim 98.

The examiner appreciates applicant's explanation of the correlation of claims 116-126 to now cancelled subject material.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 99-126 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 99 recites "a signer identifier, a date and time parameter, an IP network address, or combination of any of them, or a GUID," This is indefinite. Rewrite it as "at least one of a signer identifier, a date and time parameter, an IP network address, or a GUID,"

5. Claim 116 is directed to a method, but clauses a, b, and c are physical entities.
6. Claim 116 recites the limitations "said server computer" in clause a.ii., "the service" in clause d.i.2., "the other outputs" in clause d.i.5. There is insufficient antecedent basis for these limitations in the claim. Delete "other".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 99, 100, 107-109, and 113-115 are rejected under 35 U.S.C. 102(e) as being anticipated by Kocher (6188766).

Lines 26-37 of column 7 disclose many identifiers of a sending entity, some of which are explicitly sent to a timestamping archive. The archive corresponds to applicant's server system, the sending entity to applicant's client. Element 210 of figure 2 is the reception of a document from the client at the archive. This would necessitate the establishment of a document and the intent of the client to send the document to the archive.

Element 220 of figure 2 shows the archive authorizing the sender. Element 230 timestamps the document. In lines 38-45 of column 10, Kocher expands on this, saying that the timestamping might include signing. Incidentally, the identifier is also signed since it is potentially part of the document sent to the archive.

Kocher teaches TTIs in lines 48-52 of column 3, which read on unique identifiers. In lines 39-40 of column 7, Kocher mentions network addresses as identifiers. See also figure 3. Line 35 of column 7 mentions credit card numbers. In line 30 of column 7, a client authenticates itself through knowledge of a dedicated phone line number.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 101-106, 110-112, and 116-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. He does not say that the signature is performed through a symmetric encryption using a key that is derived from the unique document identifier. Please note that in lines 46-47 of column 13, Kocher says that any algorithm may be used in the signature. Official notice is taken that it is old and well known to create symmetric keys based on identifiers. This efficiently assigns keys to entities identified by the identifiers. Official notice is taken that MACs, which are essentially signatures using symmetric keys, are old and well known. These signatures are less computationally complex than public key signatures. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the signature using a keyed MAC, wherein the key was derived from the unique identifier of the document.

With respect to claim 116 and its dependents, Kocher does not teach a website. However, he does teach communications over the Internet and thus renders obvious use of a website.

Conclusion

11. The examiner recommends that applicant incorporate the subject matter of claim 63 into a claim that is otherwise identical to current claim 99.
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Epstein (6453416) – teaches proxy signing devices.
13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas J. Meislahn
Examiner
Art Unit 2137

DJM


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